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JUL 10 2007

REMARKS

This is in response to the outstanding Office Action dated April 10, 2007. Claims 1-16, 18-45, 49-51 and 59-61 have been previously canceled without prejudice or disclaimer. Applicant has canceled claims 52, 62-64, 69 and 71-73 without prejudice or disclaimer. Claims 71-73 were redundant since independent claims 17, 55 and 67 all contain the limitation that the predominant color blend in the roof covering be sufficiently prevalent to provide a roof covering with an appearance that simulates a natural slate roof.

The claims remaining in the application are 17, 46-48, 53-58, 63-68 and 70. Applicant has amended claims 53 and 54.

Applicant requests entrance of this response even though the claims have been finally rejected. This response narrows or eliminates a number of issues, thereby making the application more suitable for allowance or appeal. To overcome the objection under 35 U.S.C. §132(a) and the rejection under 35 U.S.C. §112, first paragraph, Applicant has canceled some claims, and amended other claims, and amended the specification.

In the outstanding Office Action, the amendment filed January 11, 2007 was objected to under 35 U.S.C. 132(a) as introducing new matter into the disclosure. Specifically, the Examiner asserts that although U.S. Application 09/292,488, now U.S. Patent 6,253,512, incorporated by reference into the present application, does disclose a predominant color blend in roughly 60% of the tabs, the '512 patent fails to disclose the complete range of over 50%, or the specific percentages of 55%, 56% or 58%. The Applicant has amended the specification to indicate the specific percentages, 55.6%, 56.4% and 58.3% as disclosed in the incorporated reference. Additionally, Applicant has canceled dependent claims 52, 62-64 and 69 which claimed the limitation that a predominant tab color blend occurred in over 50 percent of the tabs. Accordingly, Applicant requests withdrawal of the objection under 35 U.S.C. §132(a).

In the outstanding office action, dependent claims 52-54, 62-64 and 69 were rejected under 35 U.S.C. §112, first paragraph, for failure to provide an adequate written description. Specifically, the Examiner asserts the specification fails to describe or discuss the specific percentiles now claimed. Since, as explained above, some of those claims have been canceled and some amended, Applicant requests withdrawal of the objection under 35 U.S.C. §112, first paragraph.

In the outstanding Office Action, independent claim 67 was rejected under U.S.C. 103(a) as being unpatentable over Phillips in view of Overbury. This rejection fails to make out a *prima facie* case of obviousness because the third prong of a *prima facie* case of obviousness is not met. That provision requires that the combination of the references must meet all the limitations of the claim.

The Phillips and Overbury references teach some of the elements of Applicant's independent claim 67. However, neither the Phillips reference nor the Overbury reference teach the structural limitation in claim 67 wherein one of the color blends of the tabs occurs more frequently than any of the other color blends of the tabs to the extent that a predominant tab color blend is defined, with the other color blends being accent colors that occur less frequently in the roof covering, and with the predominant color blend being sufficiently prevalent to provide the appearance of the roof covering simulates a natural slate roof. A natural slate roof has the appearance of a predominant color, typically constituting at least about 60% of the slate tiles or the exposed surface area covered, with the remainder of the tiles being of an accent color. The element of Applicant's claim 67 missing from the combination of Phillips and Overbury is the frequency of tabs of the predominant color blend in the roof covering being sufficiently prevalent to provide a roof covering with an appearance that simulates a natural slate roof.

Overbury discloses a process of refurbishing asphalt shingles. Overbury discloses that initially, the original shingles are multi-tabbed shingles, which are described, at page 1, lines 23-27 of the specification, as having a surface layer of

comminuted material, such as crushed slate. This surfacing material would give the original roof an appearance of a single color, i.e., the color of the slate material used for the crushed slate layer. Since the color would be uniform, the original crushed slate roof covering would not have the appearance of a natural slate roof.

Overbury discloses that the original shingles can be refurbished by applying an additional layer of surfacing material, and that this layer of surfacing material can be applied in different colors. The additional surfacing material can be made of a number of materials, including crushed slate. Overbury discloses that the surfacing material can be colored, and that the colors of the additional layer of surfacing material can be arranged so that each color is confined to a portion of the strip shingle which corresponds to one tab of the shingle. Further, Overbury declares that the color of each tab is different from that of another tab. This is disclosed at page 2, lines 20-31, and also in the drawings.

At page 2, lines 90-96 of Overbury, the specification states that each shingle "will have a solid color different from other tabs in the strip, although if desired two or more adjacent tabs may now and then be given the same color." [Emphasis added]. This is a teaching that the one color would occur more frequently than other colors. However, the term "now and then" would be interpreted by a person of ordinary skill in the art to mean only occasionally, and would not be interpreted to mean that one color would be a predominant color of sufficient frequency or surface area to give the appearance of a natural slate roof.

There is no suggestion in either reference directing anyone to increase the surface exposure of any one color to make the one color a predominant color to the extent that the roof covering has an appearance that simulates a natural slate roof. Overbury's shingle disclosed in Fig. 6 shows that the leftmost tab is wider than any of the other tabs, and therefore the color of that tab would have more exposed area or coverage area when the shingles are installed as a roof covering. However, a simple analysis of Overbury's shingles, focusing on the width of each of the tabs of the

shingle in Fig. 6, indicates that at best the most predominant color, the leftmost tab in Fig. 6, would amount to about one-third of the surface area of the roof covering. This relatively low percentage would not be sufficient to make this one color a predominant color, and therefore the roof covering of this combination would not have an appearance of a natural slate roof, as defined in claim 67. Further, there is nothing in the knowledge generally possessed by one of ordinary skill in the art which would lead to modifying either of the references to provide one color of sufficient frequency or coverage area to simulate a natural slate roof.

As the Examiner points out, Overbury teaches at page 2, lines 73-78 that many variations are possible with respect to the extent portions of the shingles that are refurbished. Further, Overbury discloses at page 2, lines 16-24 that a large variety of combinations of shapes can be used, and that a variety of colors can be used. Nevertheless, these disclosures are not enough to constitute a suggestion to provide a predominant color sufficient to give the appearance of a natural slate roof. There is nothing in the references, even when supplemented by the general knowledge attributable to the skilled artisan, disclosing the presence of one color in an amount sufficient to provide the appearance of a natural slate roof, or suggesting a modification of either the Phillips or Overbury references to achieve such a predominant color. Therefore, the rejection fails to meet the third prong of a *prima facie* case of obviousness, and claim 67 is patentable over the references. Accordingly, Applicant requests withdrawal of the rejection of claim 67.

Since claims 68 and 70 depend on claim 67, for at least this reason, those claims are also patentable. Further, claim 68 defines a roof covering wherein the predominant tab color blend occurs in roughly 60 percent of the tabs. This limitation is nowhere disclosed in either the Phillips or the Overbury references, and therefore claim 68 is independently patentable over the references.

In the outstanding Office Action, independent claims 17 and 55 were rejected under U.S.C. 103(a) as being unpatentable over Hulett in view of Overbury.

The Overbury reference has been discussed above. The Hulett reference discloses laminated shingles having overlay members provided with a plurality of generally rectangular tabs (Figures 5,6 and 8) separated by cutouts and underlay members provided with darker granules for a more pleasing appearance. The cutouts are shown narrow when compared to the tabs. However, as noted by the Examiner, Hulett fails to teach that the color blends of the tabs of the overlay members are different from another with one of the color blends occurring more frequently than any of the other color blends.

The combination of Hulett and Overbury fails to make a prima facie case of obviousness because, in the same manner as was the case with the combination of Overbury and Phillips above, there is no teaching or suggestion in either of the references to provide a roof covering with a predominant tab color blend, with the frequency of tabs of the color blend in the roof covering being sufficiently prevalent to provide the roof covering with an appearance that simulates a natural slate roof. Therefore, the rejection fails to meet the third prong of a prima facie case of obviousness, and claims 17 and 55 are patentable over the references. Accordingly, Applicant requests withdrawal of the rejection of claims 17 and 55.

Since claims 46-48, 53-54, and 65 depend on claim 17, and since claims 56-58 and 66 depend on claim 55, for at least this reason, those claims are also patentable. Further, claims 46 and 56 define a roof covering wherein the predominant tab color blend occurs in roughly 60 percent of the tabs. This limitation is nowhere disclosed in either the Hulett or the Overbury references, and therefore claims 46 and 56 are independently patentable over the references.

In the outstanding Office Action, independent claims 17 and 55 were rejected under U.S.C. 103(a) as being unpatentable over Bondoc in view of Overbury.

The Bondoc and Overbury references teach some of the elements of Applicant's independent claims 17 and 55. The Examiner asserts that Bondoc provides laminated shingles having overlay members provided with a plurality of

generally rectangular tabs 16 and separated by narrow cutouts, which have beveled edges in the embodiment of Figures 4A-4C, and underlay members 11, 15 provided with darker granules. The cutouts are shown narrow when compared to the tabs.

Bondoc fails to teach one of the color blends of the tabs occurring more frequently than any of the other color blends of the tabs, thereby defining a predominant tab color blend, with the other color blends being accent colors that occur less frequently in the roof covering, so that the appearance of the roof covering simulates a natural slate roof.

To overcome the deficiencies in Bondoc, the Examiner relies on Overbury. However, for the same reasons stated above, the Overbury reference does not teach a roof covering as claimed in Applicant's claims 17 and 55. Specifically, there is no teaching or suggestion in either of the references to provide a roof covering with a predominant tab color blend, with the frequency of tabs of the color blend in the roof covering being sufficiently prevalent to provide the roof covering with an appearance that simulates a natural slate roof. Accordingly, a combination of the Bondoc and Overbury references does not teach a roof covering as claimed in Applicant's independent claims 17 and 55. In this regard, Applicant's independent claims 17 and 55 are non-obvious under 35 U.S.C. §103(a) in view of Bondoc and Overbury. Therefore, the rejections of independent claims 17 and 55 are improper and the claims are patentable.

Dependent claims 46-48, 53-54, and 65 depend on amended independent claim 17 and for at least this reason, are also patentable.

Dependent claims 56-58 and 66 depend on amended independent claim 55 and for at least this reason, are also patentable.

Further, claims 46 and 56 define a roof covering wherein the predominant tab color blend occurs in roughly 60 percent of the tabs. This limitation is nowhere disclosed in either the Bondoc or the Overbury references, and therefore claims 46 and 56 are independently patentable over the references.

In the event the Examiner does not find the arguments presented above sufficiently persuasive to show that the present claims are patentable, Applicant is supplying a Declaration with additional evidence as to patentability. The Declaration, executed by Mr. Donn R. Vermilion, states that the level of ordinary skill in the field of shingle design would be that of a product or process engineer with at least a Bachelor's degree in engineering or science, and with at least five years of shingle process or product design experience. Mr. Vermilion, a Senior Research Associate employed by Owens Corning, has worked in various research capacities for the last 34 years, and has, most relevantly, experience as a project leader for a project to develop plastic resin tiles that simulate natural slate roofs when installed on a roof deck.

Mr. Vermilion further states that the term "natural slate roof" would have a meaning to a person skilled in the roofing art as being a roof having the appearance of exposed portions of individual tiles partially overlaid by tiles of succeeding courses of tiles. Each of the exposed portions of a tile would have a single color, with at least about 60% of the tiles being of a predominant color, and typically significantly more than 60% of the tiles, such as, for example 70-80%, with the remainder of the tiles being of an accent color.

Mr. Vermilion also states that the disclosure in Overbury that two or more adjacent tabs may now and then be given the same color would be interpreted by a person of ordinary skill in the field of shingle design to mean only occasionally, and would be not interpreted to mean that one color would be a predominant color.

Additionally, Mr. Vermilion states that the width of the leftmost tab of the shingle in Overbury's Fig. 6 is not so great that a person of ordinary skill in the art would expect the overall roof appearance to be that of a natural slate roof since there would not be a predominant color to the extent expected in a natural slate roof. Tabs having the color of the largest tab appear to cover about one-third of the exposed area of the shingles when applied on a roof as a roof covering.

In view of the above amendment and remarks, the Applicant has shown that the claims are in proper form for allowance, and the invention, as defined in the claims, is not taught nor disclosed by the applied references. Accordingly, the Applicant respectfully requests consideration and withdrawal of the objections and rejections of record, and allowance of all claims.